Robert E. West
Patent Agent
One Becton Drive, MC 089
Franklin Lakes, New Jersey 07417-1880
tel: 201.847.6782
fax: 201.847.5377
www.bd.com

BD
Helping all people live healthy lives

Fax

Company: United States Patent and Trademark Office

Fax number: (703) 872-9306

From: Robert E. West

Date: May 6, 2004

Number of Pages (including this cover): 5

If you do not receive all of the pages, please call: Lorraine Kowalchuk 201- 847-6455

Applicant(s):	M. Ishaq Haider, et al.	Atty. Docket No.:	P-5834
Serial No.:	10/659,245	Group Art Unit:	3763
Filed:	September 10, 2003	Examiner:	Kevin C. Simmons
For:	Method And Apparatus For Epidermal Delivery Of A Substance		

The following documents are attached to this facsimile:

1. Response to Restriction Requirement in response to the Office Action mailed April 14, 2004.

RECEIVED
CENTRAL FAX CENTER
MAY 0 6 2004
OFFICIAL

PATENT

Docket No. P-5834

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:	M. Ishaq Haider, et al	Conf. No.:	3493
Serial No.:	10/659,245	Art Unit:	3763
Filing Date:	September 10, 2003	Examiner:	Kevin C. Simmons

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING TRANSMITTED VIA FACSIMILE TO THE COMMISSIONER FOR PATENTS, P.O. BOX 1450, ALEXANDRIA, VA 22313-1450 ON:

May 6, 2004

BY: LORRAINE KOWALCHUK

Lorraine Kowalchuk 5/6/04
(SIGNATURE) (DATE)

RESPONSE TO RESTRICTION REQUIREMENT

This document is being filed in response to the Office Action mailed April 14, 2004 in connection with the above-referenced application. The Examiner asserts that the claims define three separate inventions, identified as Group I (Claims 1-9), Group II (Claims 10-17), and Group III (Claims 18-39). Applicants provisionally elect the inventions of Group I (Claims 1-9) and Group III (Claims 18-39).

Provisional Election and Traversal

The restriction requirement is traversed with respect to Groups I and III. The Examiner states that the inventions defined by these claims are *"related as a product and process of use"*. However, the Examiner asserts that the "*product as claimed can be used with another materially different process of using that product (MPEP 806.05(h))*"

Applicants respectfully disagree with this analysis. The claims of Groups I and III define a related product and process of use. According to (MPEP 806.05(h)), which is reproduced below for the examiner's convenience:

> If the applicant either proves or provides a convincing argument that the alternative use suggested by the examiner cannot be accomplished, the burden is on the examiner to support a viable alternative use or withdraw the requirement.

As discussed below, the product of Group I cannot be used with another materially different process, and therefore restriction of Group I (the product) and Group III (the methods) is improper and should be withdrawn. The independent claims of each group (Claims 1, 18, 30 and 37) recites the same limitation in both the product and for use in the method, i.e., *"at least one side port."* Because the claimed method uses the same product, they are connected in both design and operation. Furthermore, the claimed method and device are all structured to achieve the same effect, i.e., "adapted to penetrate skin of a subject," which is contrary to the Examiner's assertion that the product may be used in a different method. The Examiner has asserted the product of Group I may be used in the method of "*administering an anti-tumor drug to an internal portion of the body through a device that is implantable, refillable and rate controlled*". The examiner's assertion does not require the penetration of skin, and therefore, is not applicable to the product of Group I. The product of Group I is limited to devices adapted to penetrate the skin of the patient. Therefore, under MPEP 806.05(h), the restriction of the claims of Group I and Group III is improper.

Therefore, Applicants respectfully submit that the claims of Groups I and III define a single invention, varying only in scope or breadth of the definition of that invention. Restriction between these Groups is therefore improper, and withdrawal of the restriction requirement with respect to Groups I and III is respectfully requested. Therefore, applicants provisionally elect Groups I and III.

The Examiner has also requested an election to species of the subject matter specified in four Figures. The alleged Species are as follows: Species I (Fig. 1A), Species II (Fig. 1B), Species III (Fig. 2), and Species IV (Fig. 3).

Claims 1-9 are readable on alleged Species I, II, and III (Figs 1A, 1B, and 2).

Claims 10-17 are readable on alleged Species IV (Fig. 3).

Claims 18-39 are a process of use, readable on all alleged Species I-IV.

Applicants respectfully traverse the restriction requirement with respect to Species I-IV. Claim 1 is generic and covers all of the disclosed embodiments exemplified in each of the alleged Species I, II, III and IV. Although not specifically shown in Fig 3, it is understood from the specification that the apparatus of Fig. 3 contains a needle with a side port. Therefore, each of the embodiments includes *"at least one side port."* Moreover, applicants submit that the species identified by the Examiner are not distinct, are obvious variants and can be easily examined together without the need for multiple searches, considering each of the species is adapted to penetrate the skin, and contains a side port.

In view of the foregoing, Applicants respectfully request the Examiner withdraw the restriction requirement with respect to Groups I and III, and Species I, II, III and IV. Applicants also reserve the right to further define the invention with respect to the claims of non-elected Group II, or file divisional applications directed to the non-elected groups and/or species.

Election.

Should the examiner maintain the grounds for restriction, or propose an alternative ground, the applicants elect the claims of Group I (Claims 1-9) and the Species III, as embodied in Fig. 3 with traverse, reserving the right to amend and resubmit the claims of Group III (Claims 18-39) for rejoinder under MPEP 821.04. Applicants also reserve the right to further define the invention, or file divisional applications directed to the non-elected groups and/or species.

Applicants believe no fees are due in connection with filing this response. However, if any fees are due the Assistant Commissioner is hereby authorized to charge them to Deposit Account No. 02-1666.

Respectfully submitted,

Dated: May 5, 2004

By: _____

Robert E. West
Reg. No. 48,030
Agent for Applicants
(201) 847-6782

BECTON, DICKINSON AND COMPANY
1 Becton Drive
Franklin Lakes, NJ 07417